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11 JUN 2007

In re Application of :
Saito et al. :
Application No.: 10/577,876 : DECISION
PCT No.: PCT/JP04/15529 :
Int. Filing Date: 20 October 2004 : ON
Priority Date: 11 November 2003 :
Attorney Docket No.: 403696SOEI : PETITION
For: Method For Glossing Solid Surface
And Film-Forming Coating Liquid :

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 05 April 2007.

DISCUSSION

In a Decision mailed on 12 February 2007, the petition under 37 CFR 1.47(a) filed on 06 November 2006 was dismissed without prejudice because

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Masahiro Makino be excused because he allegedly refused to sign the declaration...

In support of the proposition that Mr. Makino has refused to execute the declaration, counsel has provided evidence including a copy and translation of e-mail correspondence from Mr. Makino to Naoki Ogura, dated 25 May 2006. In this e-mail, Mr. Makino states that

It's been a long time. My answer to the patent issue is the same as before. I cannot change my mind once I make a resolution. Last time I refused. So, if this time I agree, it is a contradiction.

However, this e-mail evidence does not clearly establish that Mr. Makino is refusing to sign the declaration document for the instant application under 35 U.S.C. 371. Rather, Mr. Ogura's e-mail to Mr. Makino refers to not only the declaration, but also to an assignment pertinent to the U.S., an assignment pertinent to Canada, and a preliminary amendment. The evidence of record does not clearly establish that Mr. Makino is specifically refusing to sign the declaration, as opposed to one or more of the other documents. Moreover, petitioner has not established that the refusal occurred after Mr. Makino was presented with a complete copy of the application papers for the instant application; neither the Declaration of Mr. Ogura nor the e-mail evidence of record refers to a copy of the application as having been presented to him. For these reasons, it would not be appropriate to conclude on the basis of the present record that requirement (2) has been satisfied.

In response, petitioner has clarified that Mr. Ogura's "Declaration..." specifies the application with which his email correspondence with Mr. Makino was concerned. Petitioner also interprets Mr. Makino's written refusal as a general refusal to sign "all of the documents, including the Declaration;" upon reconsideration in view of counsel's remarks, it would be appropriate to conclude that Mr. Makino's position was that cooperation with regard to "the patent issue" (such as execution of a declaration document) would not be forthcoming because same would contradict his previous behavior/position. As such, upon reconsideration, it would be appropriate to conclude that Mr. Makino refused to execute the instant application after having been presented with a copy of the application and a declaration document.

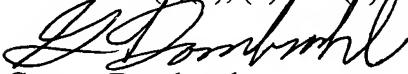
DECISION

The petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application is being returned to the National Stage Processing Branch for processing as the U.S. National Stage of the above-identified international application. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **06 November 2006**.



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